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Attorney Docket: 02280
U.S. Application No. 10/735,309 Art Unit 2611
Response to March 17, 2008 Office Action

REMARKS

In response to the Office Action dated March 17, 2008, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-38 are pending in this application, with claims 32-38 being newly added.

Objection to Claim 5

The Office objected to claim 5 for mistaken dependency. Claim 5 has been amended to correctly depend from independent claim 1.

Rejection of Claims Under § 102 (e)

The Office rejects claims 1-10 and 12-29 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Application Publication 2003/0110489 to Gudorf, *et al.* A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

These claims are not anticipated by *Gudorf*. These claims recite, or incorporate, many features that are not disclosed or suggested by *Gudorf*. Independent claim 1, for example, recites "*performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location.*" Support for such features may be found at least in the as-filed application at page 11, line 26 through page 12, line 10. Independent claim 1 is reproduced below, and independent claims 14, 23, 28, 29, 30, and 31 recite similar features.

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1. A method of capturing user commands from a viewer that are related to viewing content, comprising:

- receiving a first user command at a viewer appliance;
- performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location; and
- executing the first user command at the viewer appliance.

Gudorf does not anticipate all these features. *Gudorf* discloses click stream data that is time stamped and analyzed to determine a profile. See U.S. Patent Application Publication 2003/0110489 to *Gudorf, et al.* at paragraphs [0009] and [0010]. The clickstream data may be analyzed locally or remotely. See *id.* at paragraph [0011]. Still, though, *Gudorf* fails to teach or suggest “performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location.” Because *Gudorf* is silent to at least these features, *Gudorf* cannot anticipate independent claims 1, 14, 23, 28, and 29.

Claims 1-10 and 12-29, then, are not anticipated by *Gudorf*. Independent claims 1, 14, 23, 28, and 29 recite many features that are not taught or suggested by *Gudorf*. The dependent claims incorporate these same features and recite additional features. Claims 1-10 and 12-29, then, are not anticipated, so the Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Rejection of Claims 30 & 31 under § 102 (e)

The Office rejects claims 30 and 31 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 7,212,979 to *Matz, et al.*

Again, though, independent claims 30 and 31 are not anticipated by *Matz*. These claims again recite features that are not disclosed or suggested by *Matz*. Independent claim 30, for example, recites “performing a look-up to determine whether the first user command is locally

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stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location." Independent claim 31 recites similar features. Because *Matz* fails to teach or suggest these features, *Matz* cannot anticipate independent claims 30 and 31. The Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Rejection of Claim 11 under § 103 (a)

The Office rejects claim 11 under 35 U.S.C. § 103 (a) as being obvious over *Gudorf* in view of U.S. Patent 6,718,551 to Swix, *et al.*

Swix, however, cannot be cited against the pending claims. Subject matter that was commonly owned at the time of invention, but developed by another person, shall not preclude patentability. See 35 U.S.C. § 103 (c). This application (U.S. Application 10/875,712) and U.S. Patent 6,718,551 to Swix, *et al.* were commonly owned at the time of invention by the same assignee (namely, BellSouth Intellectual Property Corporation, now doing business as AT&T Delaware Intellectual Property, Inc.). *Swix* is a U.S. Patent with an earlier filing date and a different inventive entity. *Swix*, then, would qualify under 35 U.S.C. § 102 (e), which is precluded by 35 U.S.C. § 103 (c).

The Assignee, then, respectfully asserts that *Swix* cannot be cited against the pending claims. The Office is thus respectfully requested to remove the § 103 (a) rejections based on any combination involving *Swix*.

New Claims 32-38

This response presents new claims 32-38. Independent claim 32 presents several features that are not taught or suggested by *Gudorf*, *Matz*, and/or *Swix*, and dependent claims 33-38 incorporate these features. The Assignee thus respectfully asserts that claims 32-38 distinguish over *Gudorf*, *Matz*, and/or *Swix*. Support for these features may be found at least at column 6, lines 55-58, column 9, lines 55-67, at column 7, lines 10-11, at Table II, and at Table IV of U.S.

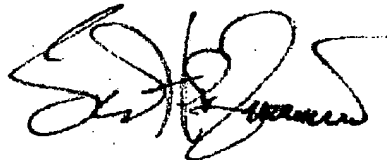
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Application 09/496,825, now issued as U.S. Patent 6,983,478 (Attorney Docket 95003 CON). Support may also be found at page 9, line 30 through page 10, line 5 of the as-filed application. Support may also be found at least in the as-filed application at page 11, line 26 though page 12, line 10.

A \$550 excess claim fee is due. New independent claim 32 requires \$200, and claims 32-38 require \$350 ($7 \times \$50 = \350). The total excess claim fee is thus \$550, and credit card authorization is enclosed.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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